REMARKS

The Office Action of September 8, 2005 continues to reject claims 22 and 24 under 35 USC §112, first paragraph as containing new matter. Curiously, the current basis given for this rejection is, ". . . because there is not expressed support for the negative limitation in the specification," with continued citation to the decision of *Ex parte Grasselli*, 231 USPQ 393. Previously in the same action, the Examiner takes the position that "the situation in *Ex parte Graseli* [*sic* Grasseli] and the present application are not ***sufficiently similar***" to support Applicant's theory of why these claims are unobjectionable. Given that this twenty-year old, never followed decision is the ***only*** authority cited in support of the instant rejections, and the Office Action admits that it deals with a situation not "sufficiently similar" to "the present application," Applicant respectfully requests the identification of proper support for the alleged lack of "express support" for the "exclusion," or withdrawal of the outstanding rejections on this basis.

While an attempt is also made to distinguish *In re Johnson*, *infra* from the present situation, nothing is said to refute the contention that ***none*** of the cited cases stand for the proposition advanced by the Examiner; namely, that a patent application must "suggest an exclusion" in order to support a negative limitation. Indeed, Applicant cites to *Ex parte Parks*, 30 USPQ2d 1234 (Bd. Pat. App. & Int. 1994), in which the Board expressly held that, despite the fact that the application failed to mention the "in the absence of a catalyst" limitation present in the claims:

> . . . it cannot be said that the originally filed disclosure would not have conveyed to one having ordinary skill in the art the *concept* of effecting decomposition at an elevated temperature in the absence of a catalyst.

Clearly, there was no "suggestion" of an exclusion of the catalyst in *Ex parte Parks*, yet the Board resoundingly rejected the notion that the "in the absence of a catalyst" limitation was "new matter." Not only does the Examiner fail to apply the holding of *Ex parte Parks* (instead citing to *In re Grasseli*, which supposedly deals with a situation that is not "sufficiently similar" to the present application), but also fails to in any way distinguish this precedential decision.

Just like in *Ex parte Parks*, the present specification clearly conveys the *concept* of using "polymer fibers other than polypropylene." The paragraph bridging pages 5 and 6 of the present specification reads as follows:

> The primary fibers 16 can be any type of fibers suitable for providing good structural qualities as well as good acoustical and thermal properties. Preferred fibers for use as the primary fibers 16 are polymer fibers . . . . A preferred type of primary fibers for use with the invention are made of polyethylene terephthalate (PET) fibers, preferably having a diameter within the range of from about 3 to about 30 microns. The primary fibers are preferably present in an amount that is within the range of from about 30 to about 95 percent by weight of the blanket of fibers, exclusive of the facing, and the bicomponent binder fibers are preferably present in an amount within the range of from about 5 to about 70 percent by weight. Most preferably, the primary fibers are PET fibers that are present in an amount that is within the range of from about 40 to about 80 percent by weight of the whole insulation product, exclusive of facings, and the bicomponent binder fibers are present in an amount within the range of from about 20 to about 60 percent by weight.

This paragraph identifies polyethylene terephthalate fibers as a preferred type of primary fiber, and proceeds to indicate that, most preferably, the primary fibers are

polyethylene terephthalate fibers in an amount that is within the range of from about 40 to about 80% by weight of the whole insulation product. Clearly, polyethylene terephthalate fibers are not polypropylene, a proposition with which the Examiner agrees. Just as clearly, this description of using PET constitutes a full and complete disclosure of the concept of utilizing "polymer fibers other than polypropylene" for the present invention. Hence, the present invention as set forth in claims 22 and 24 undoubtedly has support in the original specification and this rejections based on the alleged inclusion of "new matter" should be withdrawn.

New rejections under the "written description" requirement are now made for the first time against claim 1 (which stands canceled), as well as against claims 2-9, 11, 15-18 and 20-24. Specifically, the Examiner contends that these pending claims contain subject matter "not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." More specifically, the limitation requiring that the "primary fibers" are "substantially free of melt-blown fibers" is rejected as constituting impermissible "new matter" allegedly not described in the application as filed.

As noted above, the specification identifies the primary fibers as including polymer fibers, more preferably, polyethylene terephthalate fibers, and most preferably, polyethylene terephthalate fibers in an amount within the range of from about 40 to about 80% by weight of the entire insulation product. Clearly, no "primary fibers" are described by the Applicant as being "melt-blown," a special

type of fiber-forming process that involves "extruding molten polymer through a die and then attenuating and breaking the resulting filaments with a hot, high velocity gas stream" (*see* U.S. Patent No. 6,797,655 to Rudisill, col. 1, lines 12-15). Equally clear is full and complete disclosure of the concept of utilizing "primary fibers substantially free of melt-blown fibers," since various types of "primary" fibers are disclosed. If Applicant was "in possession" of the entire ***genus*** of "primary fibers" as of the filing date, it simply cannot be the case that it was not in possession of the narrower, subgenus of primary fibers made of polymer, but not melt-blown. *In re Johnson,* 558 F.2e 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification having described the whole, necessarily described the part remaining."). Accordingly, the present invention as set forth in claims 15, 21, and 23 has clear support in the original specification, and the rejections under 35 USC §112, first paragraph should be withdrawn.

The Office Action also rejects these same claims as also running afoul of the "enablement" requirement of 35 U.S.C. 112, first paragraph, since they allegedly contain subject matter that is not "described in the specification in such a way as to enable one skilled in the art . . . to make and/or use the invention." The specific issue raised is that the specification "fails to disclose the method used to make the primary fibers and fails to provide guidance on what are primary fibers 'substantially free of melt-blown fibers'."

Applicant respectfully submits that the specification does in fact "enable" one to make or use the claimed insulation with primary fibers that are not melt-

blown, such as those made of PET. Non-melt-blown polymer fibers and methods for making them are well known in the art. *See, e.g.*, U.S. Patent No. 2,810,426, issued October 22, 1957. Plainly then, Applicant need not disclose any method to make the "primary fibers" that are not melt-blown in order to comply with the "enablement" requirement. *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 664 231 USPQ 649 (Fed. Cir. 1986) ("a patent applicant does not need to include in the specification that which is already known to and available to one of ordinary skill in the art.").

The Examiner has not made any showing that a skilled artisan would not know how to make the primary fibers from a polymer that is not "melt-blown," which again is a highly specialized type of process involving extra processing avoided in the conventional process for making polymer fibers through extrusion (*see* U.S. Patent No. 6,797,655 to Rudisill, *supra*, which besides describing the meltblowing process, also notes that polyethylene terephthalate (Applicant's most preferred polymer fiber) is ***not*** "well adapted for making fine meltblown fibers"; see col. 1, lines 24-25)).

Moreover, no showing has been made that "undue experimentation" would be required to make polymer fibers that are not melt-blown (which would involve not "attenuating and breaking the filaments with a hot, high-velocity gas stream). Indeed, the Examiner did not raise any issue regarding enablement when Applicant's claims broadly recited "polymer fibers," but now curiously finds the claims non-enabled when they specifically exclude a more complicated processing

step that what would ordinarily be required for producing polymer fibers that are not "melt-blown." Since there is simply no basis for concluding that a skilled artisan would not understand how to make or use polymer fibers that are not "melt-blown," withdrawal of the rejections based on lack of enablement is respectfully requested.

As for the rejections based on "indefiniteness" under 35 U.S.C. Section 112, second paragraph, Applicant amends claims 15, 22, and 23 to omit the word "substantially." This removes any doubt as to what "percentage" of the fibers may be "melt-blown," and thus avoids the issue raised by the Examiner.

Substantively, the Examiner also continues to assert that U.S. Patent 5,773,375 to Swan et al. anticipates the invention as set forth in claims 1-9, 15-18, 21 and 23. First of all, it is again noted that claim 1 stands ***canceled***, and is thus not subject to rejection. Secondly, it is again emphasized that the utilization of melt-blown polypropylene fibers in an insulation web is a critical aspect of the Swan et al. patent. The entire objective and intent of the patent is to thermally stabilize these fibers for such use. Thus, considering the Swan et al. reference "as a whole," it positively and absolutely teaches the use of melt-blown polypropylene fibers in any insulation web and ***nothing else!***

In stark and total contrast, independent claims 15, 21 and 23 of the present application all reference an acoustical insulation product wherein the blanket of polymer fibers includes primary fibers "free of melt-blown fibers." Since melt-blown fibers are at the very core of the Swan et al. reference and its teachings, it

cannot possibly anticipate the presently claimed product including primary fibers free of melt-blown fibers.

The relevant teachings of Carey et al. and EP 0538047 A1 relate to bicomponent fibers and fail to address the shortcoming noted above with respect to the primary reference to Swan et al. Stated another way, the Swan et al. reference clearly teaches that melt-blown polypropylene is the fiber of choice for acoustical insulation and nothing in Swan et al., Carey et al. or EP 0538047 A1 (whether considered alone or in combination) suggests otherwise. Thus, independent claims 15, 21 and 23 should be allowed.

The Examiner also now takes the alternative position that these claims are anticipated by the Swan et al. patent because it is "not limited to just melt-blown fibers," apparently referring to the less-than-clear passage at col. 3, lines 28-35 mentioning "staple fibers . . . as well as binder fibers." First of all, it is noted that this passage is in the "Summary of the Invention" section of the application, and that the ***invention*** of the claims is clearly limited to "a meltblown polypropylene microfiber web." This of course suggests that what is being described in the passage cited by the Examiner is not an embodiment of an acoustical insulator without meltblown fibers, but instead one that includes both meltblown fibers and the "very fine" staple fibers and binder fibers mentioned.

Secondly, the syntax of the passage relied upon by the Examiner confirms that it does not describe a distinct embodiment, but rather refers back to the acoustical insulation comprising thermoplastic melt-blown microfibers. This is

made clear by the use of the definite article "the" before "acoustical insulation web," which is previously mentioned at col. 3, line 12 using the indefinite article "a" and as including melt-blown microfibers. The transitional word "also" further suggests that the description of staple fibers is additive, rather than disjunctive. Accordingly, Applicant submits that the passage relied upon does not meet the terms of the terms of the claims under rejection with the requisite strict identity to support the extant anticipation rejections.

Claims 11, 20, 22 and 24 also clearly patentably distinguish over U.S. Patent 5,773,395 to Swan et al. when considered in combination with U.S. Patent 4,840,832 to Weinle et al. As indicated above, the primary reference to Swan et al. explicitly teaches utilizing melt-blown polypropylene as the primary fibers in an acoustical insulation product. The Examiner cites the Weinle et al. reference to teach the concept of utilizing polyethylene terephthalate bicomponent fibers as the binder fibers. This is described in the Weinle et al. patent at, for example, col. 4 lines 10-21.

Claim 11 of the present application depends from claim 21 and reads on an acoustical insulation product including among other structures a blanket of polymer fibers including primary fibers free of melt-blown fibers. Claim 11 further defines the primary fibers as being made from polyethylene terephthalate. Such a structure is simply neither shown nor suggested by the Swan et al. and Weinle et al. references, which means that they cannot possibly meet the terms of this claim.

More specifically, the primary reference to Swan et al. is solely and exclusively concerned with acoustical insulation incorporating melt-blown polypropylene fibers. This is in stark and total contrast to the insulation product set forth in present claim 11 requiring primary fibers "free of melt-blown fibers". While the secondary reference to Weinle et al. does disclose the concept of utilizing polyethylene terephthalate bicomponent fibers as binder fibers in an insulation product, the Weinle et al. reference does nothing to address the shortcoming noted above with respect to the primary reference to Swan et al. Thus, the combination of references fails to teach or suggest the present invention and claim 11 should be allowed.

Claim 20, unlike claim 11, depends from independent claim 15. Independent claim 15 does, however, also include a reference to polymer fibers including primary fibers "free of melt-blown fibers". Since the primary reference to Swan et al. explicitly teaches to one skilled in the art a preference for melt-blown polypropylene fibers, this combination of references fails to provide any basis whatsoever to support the rejection of claim 20.

Claims 22 and 24 still further define over the cited art since both of these claims refer to insulation products having primary fibers other than polypropylene. As noted above, the primary reference to Swan et al. explicitly relates to and teaches the use of polypropylene fibers in preference to all other fibers when making insulation products. Thus, once again, it should be appreciated that the

cited references teach away from the present invention and claims 22 and 24 should be allowed.

According to MPEP §2141.02, the Examiner must consider a prior art reference in its entirety, including those portions that would lead away from the claimed invention. While it is true that the cited reference to Weinle et al. refers to a headliner incorporating polymeric fibers such as "polyester, nylon, polyethylene, polypropylene and blends of fibers formed from these polymers and copolymers" (note col. 4 lines 2-6) in combination with polyethylene terephthalate bicomponent binder fibers, the Examiner cannot ignore the teachings of the Swan et al. reference that would lead one skilled in the art away from the claimed invention. In this regard it is particularly important to note that while the Weinle et al. reference issued in 1989, the Swan et al. reference is more recent, issuing in 1998. The Swan et al. reference explicitly teaches the concept of making acoustical insulation material from melt-blown polypropylene fibers because such an approach provides advantages in terms of *cost, processability and performance* (see col. 1 lines 20-27). This newer reference clearly takes precedent and suggests to one skilled in the art that the primary fibers in an insulation product should be made of melt-blown polypropylene.

Accordingly, when considered together, the Swan et al. and Weinle et al. references might suggest to one skilled in the art to prepare an insulation product from primary fibers of melt-blown polypropylene and binder fibers of bicomponent polyethylene terephthalate but in no way would the combined

references suggest to one skilled in the art to manufacture a product made in accordance with the teachings of the present invention. Only with hindsight and the utilization of the knowledge and teachings of the present invention as a guide would it be possible to utilize the disclosure in the Swan et al. and Weinle et al. references to arrive at the claimed invention. It, of course, is well established that such use of hindsight is not a proper criteria for resolving the issue of obviousness and, accordingly, these claims must be allowed. See *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Int. 1985).

In summary, all the pending claims patentably distinguish over the prior art. Upon careful review and reconsideration of these issues in view of the preceding comments, it is believed the Examiner will agree with this proposition. Accordingly, the early issuance of a formal Notice of Allowance is earnestly solicited. If any fees are required, the Examiner is authorized to debit Deposit Account No. 50-0568.

Respectfully submitted,
OWENS CORNING

James J. Dottavio
Reg. No. 40,360

Owens Corning
Patent Dept. Bldg. 11
2790 Columbus Road
Granville, Ohio 43023
(740) 321-7167

Dated: 11-28-05